

Rejection Under 35 U.S.C. § 112

In the Office Action, claims 1 - 6 and 15 - 20 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 15, and 17 have been amended to more particularly point out and distinctly claim Applicant's invention and not to narrow them to avoid prior art.

Rejections Under 35 U.S.C. § 102

In the Office Action, claims 1 - 3 and 14 - 16 were rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Taylor et al. (U.S. Patent No. 6,304,773, hereinafter Taylor).

Applicant does not admit that Taylor is prior art, and reserves the right to swear behind it at a later date. Also, the Office Action fails to show, as required by 37 CFR § 1.104 (c)(2), the particular parts of Taylor relied upon. Nevertheless, Applicant respectfully submits that the claims are distinguishable over Taylor for the reasons argued below.

Claim 1 - 3, and 14:

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). Applicant respectfully traverses the rejection because each element of the rejected claim is not disclosed in Taylor.

Taylor describes an external defibrillator that evaluates cardiac asystole and indicates to an operator that a patient needs emergency defibrillation.

Applicant is unable to find in Taylor the feature relating to calculating at least one suggested pulse generator setting from the set of possible pulse generator settings, as recited in amended claim 1.

Claims 2, 3, and 14 are ultimately dependent on claim 1 and are allowable for the reasons, stated above, for amended claim 1.

Claim 14 additionally recites programming an implantable pulse generator with the suggested pulse generator settings. Applicant is unable to find such an element described in

Taylor.

Applicant respectfully requests reconsideration and allowance of claims 1 - 3, and 14.

Claims 15 and 16:

Applicant respectfully traverses the rejection because each element of amended claim 15 is not disclosed in Taylor. For example, Applicant is unable to find in Taylor, among other things, a display screen to display screen displays the subset of suggested pulse generator settings of the set of possible pulse generator settings, as recited in amended claim 15.

Claim 16 is dependent on claim 15 and is allowable for the reasons, stated above, for amended claim 15.

Applicant respectfully requests allowance of claims 15 and 16.

Rejections Under 35 U.S.C. § 103

In the Office Action, claims 1 - 3 and 14 - 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cohen (U.S. Patent No. 5,174,289).

Claim 1 - 3, and 14:

Applicant respectfully traverses the rejection. The Office Action failed to make out a proper *prima facie* case of obviousness under 35 U.S.C. § 103 because the cited reference fails to describe or suggest all of the recited elements of claim 1.

Cohen relates to a method and apparatus for improving the ventricular activation sequence of the heart by pacing at an advantageous selected ventricular location to shorten wide QRS complexes.

Claim 1 of the application recites, among other things, calculating at least one suggested pulse generator setting from the one or more algorithms based on the first data value; and displaying the one or more suggested pulse generator settings, wherein the at least one suggested pulse generator setting is a subset of a set of predetermined acceptable pulse generator settings. Thus, the number of predetermined acceptable settings of a pulse generator is reduced to a smaller subset of suggested settings for display for an operator. In contrast Cohen does not

suggest or describe displaying suggested settings to assist an operator in programming the system. Thus, Cohen does not contain all of the elements of the recited invention.

Also, since all the elements of claim 1 are not found in Cohen, Applicant assumes that the Examiner is taking official notice of the missing elements. Applicant respectfully objects to the taking of official notice with a single reference obviousness rejection and, pursuant to M.P.E.P. § 2144.03, Applicant respectfully traverses the assertion of Official Notice and requests that the Examiner cite references in support of this position.

Claims 2, 3, and 14 are ultimately dependent on claim 1 and are allowable for the reasons, stated above, for claim 1.

Applicant respectfully requests reconsideration and allowance of claims 1 - 3, and 14.

In the Office Action, claims 4 - 6 and 17 - 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cohen (U.S. Patent No. 5,174,289) in view of Struble (U.S. Patent No. 5,174,289).

Claims 4 - 6:

Applicant respectfully traverses the rejections. Claims 4 - 6 are ultimately dependent on claim 1 and are allowable for the same reasons, as stated above, for claim 1.

Also, the Office Action fails to make out a proper *prima facie* case of obviousness by not providing objective evidence of a suggestion or motivation to make the combination of the cited references. The Office Action stated it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the pacing system of Cohen to include measuring the difference between right and left ventricular contractions as taught by Struble for providing a secondary indication of a treatable arrhythmia (such as right or left bundle branch block) and providing assurance of the presence of such an arrhythmia before initiating a potentially uncomfortable, unnecessary, and even damaging pacing regimen. This statement in the Office Action appears to reflect a subjective conclusion belief not based upon either of the cited patents but based on the teachings of the Applicant's patent application. The rejection therefore fails to satisfy the requirement for objective evidence of a motivation other than

hindsight to make the combination of the cited references.

Applicant respectfully requests reconsideration and allowance of claims 4-6.

Claims 17 - 20:

Applicant respectfully traverses the rejections. Claims 17 - 20 are ultimately dependent on claim 15 and are allowable for the reasons, stated above, for claim 15.

Applicant further traverses the rejections because the cited references in combination do not describe all of the elements of claims 17 - 20. For example, Applicant is unable to find a description in the cited references of where a medical device programmer suggests "one or more ventricular chambers in which to provide pacing pulses based on the duration interval of the QRS complex and the difference between R_L and R_R ," as recited in claim 17.

Applicant respectfully requests reconsideration and allowance of claims 17 - 20.

In the Office Action, claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Cohen (U.S. Patent No. 5,174,289) or Taylor et al. (U.S. Patent No. 6,304,773).

Applicant respectfully traverses the rejection. Claim 13 is ultimately dependent on claim 1 and is allowable for the reasons, stated above, for claim 1.

Also, the Office Action fails to make out a proper *prima facie* case of obviousness, as required under 35 U.S.C. § 103, because the combined cited patents do not describe each of the elements recited in claim 13. Applicant is unable to find in Cohen or Taylor a feature corresponding to "receiving a request to display one or more suggested pulse generator settings, and displaying an estimated time to complete executing the one or more algorithms to calculate the suggested pulse generator settings", as recited in claim 13.

Applicant respectfully requests reconsideration and allowance of claim 13.

CONCLUSION

Claims 1, 15, and 17 are amended herein. Claims 7 - 12, 21 - 29 are cancelled hereby without prejudice. Claims 1 - 6, 13 - 20 are now pending.

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6912) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 25th day of November, 2002.

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Signature [Signature]